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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: **Alvin C. Allen, Jr.**	§	Group Art Unit: **2683**
Serial No.: **09/206,627**	§	
Filed: **December 7, 1998**	§	Examiner: **R. Perez-Gutierrez**
Title: **Apparatus and Method for Triggerable Location Reporting**	§	Attorney Docket No: **069131.0102**

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BOARD OF PATENT APPEALS AND INTERFERENCES

Honorable Commissioner for Patents
Washington, D.C. 20231
Attention: Board of Patent Appeals and Interferences

Dear Sir:

APPELLANT'S BRIEF (37 C.F.R. § 1.192)

This brief is submitted in support of appellant's notice of appeal from the decision dated July 12, 2001 of the Examiner.

This brief is transmitted in triplicate per 37 C.F.R. § 1.192.

I. IDENTIFICATION OF THE REAL PARTY OF INTEREST

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The real party in interest is:

LunarEYE, Inc.
2003 Highway 90
Liberty, Texas 77575

by virtue of an assignment by the inventor as duly recorded in the Assignment Branch of the U.S. Patent and Trademark Office. The assignment was to Global Trak, Inc., which has since changed its name to LunarEYE, Inc.

II. IDENTIFICATION OF RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences, to Applicant's knowledge.

III. STATUS OF ALL THE CLAIMS, PENDING OR CANCELLED, AND IDENTIFYING THE CLAIMS APPEALED

The application as originally filed contained 33 claims. Claims 1-11, 14, 16-22 and 24-33 are pending and are appealed. Claims 12-13, 15 and 23 have been cancelled.

IV. STATUS OF ANY AMENDMENT FILED SUBSEQUENT TO FINAL REJECTION

Applicant amended claims 1, 8, 19 and 26 after the final rejection in a response filed on September 12, 2001. In an advisory action dated October 10, 2001, the Examiner indicated that the proposed amendments would be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees. The Notice of Appeal and fee were submitted on November 13, 2001. Presumably Applicant's September 12, 2001 amendment will be entered upon submission of this Appeal Brief. Applicant's September 12, 2001 amendment should have mooted the examiner's objections and rejections under 35 USC 112.

In the Final Office Action the examiner objected to the declaration. A new declaration was filed, which should have mooted this objection.

V. SUMMARY OF THE INVENTION

Applicant's invention is a triggerable location-reporting apparatus (12) and method that provides the ability to report its position in response to a trigger signal using a cellular Reverse Control Channel signal specially modified to accomplish this purpose. The triggerable location-reporting apparatus (12) also includes a controller (36) that only enables portions of its circuitry when it receives the trigger signal and subsequently disables those portions of the circuitry.

The fact that the triggerable location-reporting apparatus disables portions of the circuitry is very important because, in a normal cellular environment where the controller is attached to a moving vehicle, the cellular network transmitter (54) would transmit a Reverse Control Channel signal every time it entered the environment of a new cellular base station, incurring a cellular system cost for each transmission. The invention avoids this cost by disabling the cellular

network transmitter (54). This aspect of the invention makes it commercially viable as a theft prevention or recovery device or as a means of tracking and controlling virtually anything.

VI. CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The examiner rejected claims 26-33 under 35 USC 102(e) as being anticipated by Janky et al. (United States Patent Number 5,777,580). The examiner argued that Janky inherently discloses an enable controller that disables a location-signal generating device and a telemetry transmitter after the telemetry transmitter transmits a location signal. The applicant disagrees that Janky makes such a disclosure, expressly or inherently.

The examiner rejected claims 1-11, 14, 16-22, 24 and 25 under 35 USC 103(a) as being unpatentable over Janky in view of Westerlage et al. (United States Patent Number 5,826,195). The examiner argued that, inherently, Janky's controller 25 (enable controller) is configured to put back to sleep (disable, switch off) the LDS receiver/processsor 31 (GPS receiver) and the IS communications transmitter or responder means 27 (cellular network transmitter). The applicant disagrees that Janky makes such a disclosure, expressly or inherently.

VII. GROUPING OF CLAIMS

Claims 26-33 stand or fall together.

Claims 1-11, 14, 16-22, 24 and 25 stand or fall together.

VIII. ARGUMENTS OF THE APPELLANT, WITH EACH ISSUE IN SEPARATE HEADINGS, WITH RESPECT TO EACH ISSUE PRESENTED FOR REVIEW

A. Janky does not anticipate claims 26-33 because Janky does not include a controller that expressly or inherently disables the telemetry transmitter after it transmits the location signal, as required by claim 26

In the Final Office Action in this matter, the examiner rejected claims 26-33 under 35 USC 102(e) as being anticipated by Janky et al. (U.S. Patent Number 5,777,580). Claim 26 requires, in pertinent part, "an enable controller configured to enable the location-signal generating device and the telemetry transmitter when it receives a trigger signal and to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal." Claims 27-33 depend from claim 26.

In the rejection of claims 26-33, the examiner argued that Janky shows a controller 25 "configured . . . inherently, to put back to sleep (disable) the LDS receiver/processor 31 (location-signal-generating device) and the IS communications transmitter or responder means 27 (telemetry transmitter) after the IS communications transmitter or responder means 27 (telemetry transmitter) transmits the location signal." (emphasis added) *See* page 5 of the Final Office Action.

The rejection of claims 26-33 can be upheld only if it is inherent in Janky for the enable controller to disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. This limitation is inherent in Janky only if Janky necessarily includes the claimed limitations. *See In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). "To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to extrinsic evidence. Such evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co., U.S.A. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 USPQ2d 1746 (Fed. Cir. 1991) (emphasis added).

Thus, to uphold the rejection of claims 26-33, the structure corresponding to the enable controller in Janky must necessarily disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal. But that is not true. While Janky's enable controller may perform this function, "[i]nherency . . . may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient." *Continental Can*, 948 F.2d at 1269 (citing *In re Oelrich*, 666 F. 2d 578, 581, 212 U.S.P.Q. 323, 326 (CCPA 1981)) (emphasis in original). For example, instead of performing as the examiner suggests, the system in Janky may leave the telemetry transmitter system enabled after it transmits the location signal. It may continue to transmit the location signal continuously or periodically until it is unenabled by a person performing an action, such as removing power from the telemetry transmitter system, rather than such action being performed by the enable controller. Janky could be used in such a manner when the vehicle in which it is installed is stolen. In that situation, it might be useful to transmit the location signal on a continuous basis to allow the stolen vehicle to be continuously tracked.

Thus, the enable controller in Janky does not necessarily disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by claim 26, and Janky does not inherently include this limitation.

In the advisory action in this matter, the examiner argued that "inherency can be established '[i]f ... the disclosure is sufficient to show that the natural result flowing from the operation as taught would result in the performance of the questioned function.'" (*citing Continental Can Co.*, 948 F.2d at 1268). The examiner further observed that "Janky et al. further disclose that LDS receiver/processor (location-signal generating device) is awakened by the controller (enable controller) only when a trigger event occurs (column 11 lines 31-40) and that the IS responder/transmitter means 27 (telemetry transmitter) can contact the IS contact receiver **only once** (column 12 lines 24-26)." (Emphasis in original). From this, the examiner concludes that Janky's "controller (enable controller), inherently, disables the LDS receiver/processor (location-signal generating device) and the IS responder/transmitter means 27 (telemetry transmitter) after the responder/transmitter means 27 (telemetry transmitter) transmits the location signal."

The examiner's basic premise is incorrect because the portion of Janky upon which the examiner relies does not teach that its telemetry transmitter is disabled after transmitting the location signal, as required by claim 26. Janky discloses that "the controller 25 causes the IS responder/transmitter means 27 and associated IS antenna 29 to contact a selected IS contact number at an IS contact receiver 43." (column 12, lines 16-18, emphasis added) Subsequently, "the IS responder/transmitter means 27 transmits the vehicle location information in a short burst of data contained in an IS response signal, in step 63." (column 12, lines 20-22, emphasis added) As can be seen, Janky uses "contact" to describe creating the communications link between the IS responder/transmitter means 27 and the IS contact receiver 43, and "transmit" to describe transmitting the vehicle location information.

In the pivotal language relied on by the examiner, "the IS responder/transmitter means 27 may contact the IS contact receiver 43 only once, as desired," column 12, lines 25-26, Janky used the verb associated with setting up the communications link ("contact"), not the verb associated with transmitting the vehicle location information ("transmit"). Thus, this language is referring to setting up a communications link only once, not transmitting the vehicle location

information only once. Even if the IS responder/transmitter means 27 contacts the IS contact receiver 43 only once, there is nothing in Janky that suggests that it transmits the vehicle location information only once during the single contact with the IS contact receiver. Thus, Janky does not expressly or inherently teach or suggest that the controller disables the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal, as required by claim 26.

Even if it is found that Janky teaches that its telemetry transmitter is disabled after transmitting the location signal, it does not expressly or inherently teach or suggest that the enable controller does the disabling, as required by claim 26. In fact, it is possible to imagine a number of ways that the telemetry transmitter might be disabled: (1) it disables itself; (2) it is disabled by another device in the system, not the enable controller; (3) it is manually disabled; or (4) it is disabled by the enable controller. Thus, even assuming Janky teaches disabling its telemetry transmitter after transmitting the location signal, the natural result flowing from the operation taught by Janky would be that Janky's responder/transmitter means 27 is disabled after one transmission, not that Janky's controller disables the responder/transmitter means 27. Consequently, the requirement in claim 26 that the enable controller disables the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal is neither expressly nor inherently taught by Janky.

Janky does not include "an enable controller configured to ... disable the location-signal generating device and the telemetry transmitter after the telemetry transmitter transmits the location signal," as required by claim 26, either expressly or inherently and, consequently, it does not anticipate claim 26. Claim 26 is patentable over Janky.

Claims 27-33 depend from claim 26 and are patentable for at least the same reasons. The rejection of claims 27-33 should be reversed.

B. Janky does not render claims 1-11, 14, 16-22, 24 and 25 obvious for the same reasons

The examiner rejected claims 1-11, 14, 16-22, 24 and 25 under 35 USC 103(a) as being unpatentable over Janky et al. (U.S. Patent Number 5,777,580) in view of Westerlage et al. (U.S. Patent Number 5,826,195). Claim 1 requires "an enable controller being configured to disable the GPS receiver and the cellular network transmitter." Claim 19 requires "disabling the GPS receiver and the cellular network transmitter."

In rejecting claims 1-4, 19, 20 and 22, the examiner made essentially the same inherency argument as with claim 26: that Janky inherently shows "the controller 25 (enable controller) being configured to put back to sleep (disable, switch off) the LDS receiver/processor 31 (GPS receiver) and the IS communications transmitter or responder means 27 (cellular network transmitter)."

As discussed above with respect to claim 26, Janky does not include this feature either expressly or inherently. The examiner implicitly admitted that Westerlage does not include this feature, which means that the examiner's proposed combination of Janky and Westerlage would not include this feature. Thus, claims 1-4, 19, 20 and 22 would not have been obvious to a person of ordinary skill at the time this application was filed over Janky in view of Westerlage. Thus, claims 1-4, 19, 20 and 22 are patentable over Janky in view of Westerlage.

Claims 3-11, 14, 16-18, 21 and 23-25 depend from one or more of claims 1-4, 19, 20 and 22, and are patentable for at least the same reasons. The rejection of claims 1-11, 14, 16-22, 24 and 25 should be reversed.

Summary

The rejection of the pending claims should be reversed because Janky does not expressly or inherently provide the teaching alleged by the examiner.

Respectfully submitted,

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Date: January 11, 2002

APPENDIX

1. (twice amended) A triggerable location-reporting apparatus for use in an environment including: a source of Global Positioning Satellite System (GPS) signals; a source of a trigger signal; a cellular base station connected through a network to a gateway; the cellular base station being configured to expect a Reverse Control Channel signal including a Mobile Identification Number and an Electronic Serial Number, the triggerable location-reporting apparatus comprising:

a GPS receiver responsive to the GPS signals for producing GPS data when enabled;

a cellular network transmitter coupled to the GPS receiver for formatting and transmitting, when enabled, a Reverse Control Channel signal including a formatted GPS data in the place normally occupied by the Electronic Serial Number and a Mobile Identification Number that will cause the cellular base station to send a Registration Notification Invoke signal including the formatted GPS data to the gateway;

a trigger signal receiver responsive to the trigger signal for producing an enable signal;

an enable controller coupled to the GPS receiver, the cellular network transmitter, and the trigger signal receiver;

the enable controller being configured to enable the GPS receiver and the cellular network transmitter upon receipt of the enable signal from the trigger signal receiver; and

the enable controller being configured to disable the GPS receiver and the cellular network transmitter.

2. (amended) The triggerable location-reporting apparatus of claim 1 further comprising
a power supply connection;
a first switchable power signal coupled to the GPS receiver and the power supply connection;
a second switchable power signal coupled to the cellular network transmitter and the power supply connection.

3. (amended) The triggerable location-reporting apparatus of claim 2 where
the enable controller is configured to switch on and off the first switchable power signal and the second switchable power signal.

4. The triggerable location-reporting apparatus of claim 2 further comprising
a power supply coupled to the power supply connection.

5. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a battery.

6. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a solar cell.

7. The triggerable location-reporting apparatus of claim 4 wherein
the power supply comprises a vehicle battery.

8. (twice amended) The triggerable location-reporting apparatus of claim 1 wherein
the trigger signal receiver, GPS receiver and cellular network transmitter are housed in a housing.

9. The triggerable location-reporting apparatus of claim 8 wherein
the housing is configured to be installed in a vehicle.

10. The triggerable location-reporting apparatus of claim 8 wherein the housing comprises at least a portion of an article of clothing.

11. The triggerable location-reporting apparatus of claim 8 wherein the housing is configured to be installed in an object to be tracked.

12. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a cellular telemetry transmitter.

13. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a satellite telemetry transmitter.

14. (amended) The triggerable location-reporting apparatus of claim 1 wherein the cellular network transmitter comprises a cellular telephone.

15. (cancelled) The triggerable location-reporting apparatus of claim 1 wherein the telemetry transmitter comprises a radio-telephone.

16. (amended) The triggerable location-reporting apparatus of claim 1 wherein the trigger signal comprises a page.

17. (amended) The triggerable location-reporting apparatus of claim 1 wherein the source of the trigger signal comprises an alarm.

18. (amended) The triggerable location-reporting apparatus of claim 1 wherein the source of the trigger signal comprises a remote control.